

Application Serial No.: 09/684,965
Reply to Office Action dated June 6, 2005

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-51, 54-56, 58-60, 62-64, 66-68, 70-72, and 74-76 are presently active in this case, Claims 1, 13, 25, 37, 42, 47, 54, 58, 62, 66, 70, and 74 having been amended and Claims 52, 53, 57, 61, 65, 69, and 73 having been canceled without prejudice or disclaimer by way of the present Amendment.

Claims 1-51 and 53-76 were rejected under 35 U.S.C. 103(a) as being unpatentable over Delano (U.S. Patent No. 6,430,558) in view of Busey et al. (U.S. Patent No. 6,377,944). Claims 9, 10, 21, 22, 33, and 34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Delano in view of Busey et al. and further in view of Kenner (U.S. Patent No. 6,112,239). For the reasons discussed below, the Applicants request the withdrawal of the art rejections.

Subject matter from Claims 54, 58, 62, 66, 70, and 74 has been incorporated into independent Claims 1, 13, 25, 37, 42, and 47, respectively. More specifically, the independent claims have been amended to recite that the consulting advice recited therein includes advice on document retrieval costs, document storage strategies, document storage organization, protection of secured documents, or delivery options of documents. The Applicants submit that the cited references, either when taken singularly or in combination, fail to disclose or suggest the above features of the independent claims.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicant submits that a *prima facie* case of obviousness has not been established in the present case because the references, either when taken singularly or in combination, do not teach or suggest all of the claim limitations.

The Official Action cites the Delano reference for the teaching of the subject matter from Claims 54, 58, 62, 66, 70, and 74 which has been incorporated into the independent claims. More specifically, the Official Action indicates that column 2, line 63, through column 3, line 39, column 4, lines 10-28, and column 5, line 55, through column 6, line 25, teaches consulting advice that includes advice on document retrieval costs, document storage strategies, document storage organization, protection of secured documents, or delivery options of documents. The Applicants respectfully disagree.

The section of the Delano reference cited in the Official Action describes “search recommending means, e.g., a recommender 42, responsive to the plurality of serving means 12 for recommending at least one of content providing (including content linking), alternative searching, and alternative browsing queries to a user of the collaborative searching engine 20 through at least one of the plurality of client user interfacing means 18, and modification notifying means, e.g., notifications 26, responsive to the plurality of serving means 12 for providing notification of updates to the knowledge database 25.” The Delano states that “[f]or example, a user acting as a Searcher entity 32 may search for information on a topic and then act as a Recommender entity 42 to recommend some new content that they have

found for that topic or another topic.” Thus, the Delano reference merely discusses the population of a knowledge database with information regarding searching recommendations. The Delano reference does not disclose or even suggest consulting advice that includes advice on document retrieval costs, document storage strategies, document storage organization, protection of secured documents, or delivery options of documents, as recited in the independent claims of the present application.

Furthermore, the Busey et al. reference was cited for the teaching of a step of receiving a request from a remote user. However, the Busey et al. reference fails to supplement the above deficiency in the teachings of the Delano reference. More specifically, the Busey et al. reference does not disclose or even suggest consulting advice that includes advice on document retrieval costs, document storage strategies, document storage organization, protection of secured documents, or delivery options of documents, as recited in the independent claims of the present application.

Since the Delano reference and the Busey et al. reference, either when taken singularly or in combination, fail to disclose or suggest all of the limitations recited in independent Claims 1, 13, 25, 37, 42, and 47, the Applicants submit that a *prima facie* case of obviousness cannot be established with respect to these claims. Accordingly, the Applicants respectfully request the withdrawal of the obviousness rejections of Claims 1, 13, 25, 37, 42, and 47.

The dependent claims are considered allowable for the reasons advanced for the independent claims from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the

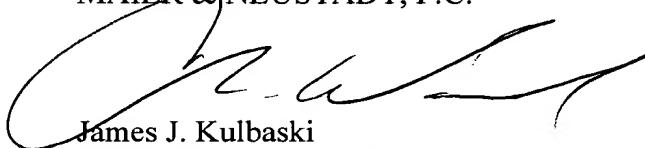
Application Serial No.: 09/684,965
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applied references when those features are considered within the context of their respective independent claims.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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